

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kenneth L. Miller
Serial No.: 10/784,353
Filing Date: February 23, 2004
Confirmation No.: 2325
Group Art Unit: 3714
Examiner: Ryan Hsu
Title: METHOD FOR WAGERING

Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review (this "Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below. Claims 1-17 and 23-35 are pending in this Application. In a Final Office Action dated July 11, 2007 (the "*Final Office Action*"), the Examiner rejected Claims 1-17 and 23-35. Applicants respectfully contend that the rejection of Claims 1-17 and 23-35 on all grounds presented by the Examiner contain clear legal and factual deficiencies.

Rejection of Claims 1-6, 14-17, and 22-29 under 35 § 102(e)

The Examiner rejects Claims 1-6, 14-17, and 22-29 under 35 U.S.C. § 102(e) in light of U.S. Patent No. 5,830,068 to Brenner (*"Brenner"*). *Final Office Action*, p. 3. As discussed further below, Applicant respectfully submits that these rejections are legally and/or factually deficient for at least several reasons. As a result, Applicant requests reconsideration and allowance of these claims.

For example, *Brenner* fails to recite, explicitly or inherently, every element of Claim 1. As Applicant previously noted (see, e.g., Applicant's Response to Office Action filed April 9, 2007 (the *"April 9 Response"*), p. 13), *Brenner* fails to disclose *"allowing a player to choose a plurality of the event's races to be included in the wager, wherein the player is required to choose a number of chosen races equal to the predetermined quantity of the event's races."* As Applicant has previously explained (see, e.g., *April 9 Response*, pp. 13-15), the Examiner's rejection conflates the bettor's ability to select multiple races on which to place multiple different bets (e.g., as described in the discussion of example operation at col. 4, ll. 22-42) with the bettor's ability to select winners within particular predetermined races in a single Pick-N or Daily Double bet. Nonetheless, a bettor using the *Brenner* system cannot select the races to be included in a Daily Double or Pick-N bet.

Thus, to the extent that the Examiner is attempting to equate a bettor submitting a series of multiple different bets (e.g., according to the example operation described by *Brenner* at col. 4, ll. 22-42) with *"choos[ing] a plurality of the event's races to be included in the wager,"* Applicant respectfully notes that a series of bets, even if submitted to the *Brenner* system simultaneously, would not be included in the same *"wager"* such that the *Brenner* system *"pay[s] the [bettor] if a predetermined number of the selected winners win corresponding chosen races"* as required by Claim 1. Instead, such a series of bets would represent multiple different wagers on multiple different races with independent payoffs.

Moreover, to the extent that the Examiner is equating a bettor picking winners of the predetermined races in a Daily Double or Pick-N bet (e.g., *Brenner*, col. 11, ll. 27-32) with *"allowing a player to choose a plurality of the event's races to be included in the wager,"* Applicants respectfully note that Daily Double/Pick-N bets do not allow the bettor to select the races on which to bet. Even the reference cited by the Examiner (*"TAB: How to Play,"* p. 2) as providing a description of Pick-N bets (in this case, a Pick-6 bet) indicates that the races included in the Pick-6 bet are selected by the race organizer. (*"These races are selected by the TAB and indicated in the Events Open for Betting area on this site."* *Id.*, emphasis added.) As a result, when placing a Daily Double / Pick-N bet, the bettor only selects the winners of predetermined races, the bettor does not select the races to be included in the bet. Thus, even when a bettor is placing a Daily Double / Pick-N, the system disclosed by *Brenner* does not *"allow[] a player to choose a plurality of the event's races to be included in the wager"* as the exact set of races included in the Daily Double / Pick-N bet is determined by the race organizer, not the bettor.

In response to this argument, the Examiner asserts that “encapsulated within the general capabilities of the system, Brenner allows a bettor to select several different types of bets.” *Final Office Action*, p. 11. According to the Examiner, “most of these bets such as a win, place, or show have a predetermined quantity of one to be made,” but “others such as a daily double or pick-n bet necessitate a limitation of allowing the bettor to have the predetermined quantity of selections to be 2 or ‘n’.” *Id.* The Examiner closes by alleging that “the current claims limitations have not precluded the Examiner from taking either interpretation and have not differentiated the difference between these two interpretations.” *Id.*

Applicant notes, however, that the Examiner’s response still ignores the fact that the bettor cannot select the races to be included in a Daily Double or Pick-N bet. More specifically, when a bettor using the Brenner system places a series of multiple independent bets the *Brenner* system does not “allow[] [the bettor] to choose a plurality of the event’s races to be included in the wager,” (emphasis added) and the bettor is not “required to choose a number of chosen races equal to the predetermined quantity of the event’s races” (emphasis added). Furthermore, when a bettor using the *Brenner* system places a Daily Double or Pick-N bet, the bettor does not “choose” any races, let alone “choose a number of chosen races equal to [a] predetermined quantity of event’s races.” Thus, when placing a bet in either context, a bettor using the *Brenner* system will not be “allow[ed] . . . to choose a plurality of the event’s races to be included in the wager, wherein the [bettor] is required to choose a number of chosen races equal to the predetermined quantity of the event’s races” as recited by Claim 1.

For a rejection under 35 U.S.C. § 102 to be proper, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” and “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (emphasis added). As discussed above, the Examiner’s rejection of Claim 1 under 35 U.S.C. § 102 fails to satisfy this requirement. As a result, this rejection is factually and/or legally deficient, and Claim 1 is thus allowable. Although of differing scope from Claim 1, Claim 6 includes elements that are not disclosed by *Brenner* for reasons substantially similar to those discussed with respect to Claim 1. Claims 1 and 6 are thus allowable for at least these reasons. Applicant respectfully requests reconsideration and allowance of Claims 1 and 6, and their respective dependents.

Rejection of Claims 9-12, 30, 32, and 34-35 under 35 § 103(a)

The Examiner rejects Claim 9-12, 30, 32, and 34-35 under 35 U.S.C. § 103(a) over *Brenner* in light of Scarne’s New Complete Guide to Gambling (“*Scarne*”). *Final Office Action*, p. 7. As discussed further below, Applicant respectfully submits that these rejections are factually and/or

legally deficient for at least several reasons. As a result, Applicant requests reconsideration and allowance of these claims.

For example, as Applicants previously noted (e.g., *April 9 Response*, p. 17), *Brenner* fails to disclose “*identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected each predicted winner in the second selection for each race within the first selection.*” In addressing this limitation, the Examiner previously referenced a portion of *Brenner* that merely discusses the creation and management of a user account in the *Brenner* system. See *April 9 Response*, p. 17. Applicant noted this deficiency in the *April 9 Response*. *Id.* As a result, the Examiner now addresses this limitation by referencing a portion of *Brenner* that discusses a “data concentrator 112” that receives betting information from one or more “totalisators 102” and distributes this betting information to bettors. *Brenner*, col. 5, ll. 61-64. Among the information the data concentrator provides is payoff information on bets such as Daily Double and Pick-N bets. *Brenner*, col. 5, l. 61 - col. 6, l. 7. However, the Examiner still has not identified any portion of *Brenner* that discloses “*determining which of one or more players of the plurality of players correctly selected each predicted winner in the second selection for each race within the first selection*” as required by Claim 9. Thus, *Brenner* fails to disclose every element of Claim 9.

Combining *Brenner* with *Scarne* fails to remedy this omission as *Scarne* also fails to disclose the relevant element. *Scarne* merely describes certain types of pari-mutuel pools that may be used in horse racing. *Scarne* does not disclose “*determining which of one or more players of the plurality of players correctly selected each predicted winner in the second selection for each race within the first selection.*” Thus, the proposed *Brenner-Scarne* combination fails to disclose every element of Claim 9.

As a result, the rejection of Claim 9 under 35 U.S.C. § 103 is factually and/or legally deficient, and Claim 9 is thus allowable. Although of differing scope from Claim 9, Claim 30 includes elements that are not disclosed by the proposed *Brenner-Scarne* combination for reasons substantially similar to those discussed with respect to Claim 9. Claims 9 and 30 are thus allowable for at least these reasons. Applicant respectfully requests reconsideration and allowance of Claims 9 and 30, and their respective dependents.

CONCLUSIONS

As the rejection of Claims 1-17 and 22-35 contain clear deficiencies, Applicant respectfully requests a finding of allowance of Claims 1-17 and 22-35. To the extent necessary, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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